

Docket No.: H06291 (13744-00021)
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Jörg Feesche et al.

Application No.: 10/593,425

Confirmation No.: 5960

Filed: December 27, 2006

Art Unit: 1645

For: FACTOR RECA FROM BACILLUS
LICHENIFORMIS AND RECA-
INACTIVATED SAFETY STEMS USED FOR
BIOTECHNOLOGICAL PRODUCTION

Examiner: Virginia Allen Portner

REPLY TO BONA FIDE ATTEMPT LETTER

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Madam:

This is Applicants' Reply to the Office action mailed July 31, 2009, which comprises the Examiner's letter in which she concluded that Applicants' Response to the Office action mailed May 14, 2009 was not fully responsive because the Response did not include election of a species from within elected Group IV. Applicants inadvertent omitted this species election and thank the Examiner for correctly appraising this Response as *bona fide*, even though lacking this one responsive element.

As noted in their May 14, 2009 Response, Applicants respectfully disagree with the Examiner's contention that Applicants' claimed invention does not make a contribution over the teachings of Berka et al. in US Pat. Pub. 2008/005077 ("077 publication"), which claims benefit of the filing date, *inter alia*, of US Provisional Appl. No. 60/535,988 ("988 provisional"). Based on the distinctions addressed in that paper, the claims of Groups I-IX of Applicants' application are linked so as to form a single general inventive concept under PCT Rule 13.1 and share the

same special technical feature, that of *B. licheniformis* DSM 13 recA protein, required under PCT Rule 13.2. Accordingly, Applicants' claimed invention makes a contribution over the prior art. Applicants respectfully request incorporation into their Response of the species election herein, and reconsideration and withdrawal of the restriction requirement.

In the event that the Examiner decides to maintain her original restriction requirement, Applicants previously had elected Group IV, consisting of claims 17–21 and 23–28 (with traverse). To make their previous Response fully responsive, Applicants herein elect the species of claim 17, a gram-positive bacterium that is not *Bacillus megaterium* in which the gene *recA* is functionally inactivated. Applicants continue to reserve all rights to pursue the non-elected species in one or more divisional applications, if necessary.

In view of the above election and discussion, Applicants believe that they have corrected the previous Response, which now is fully responsive, and that the pending application is in condition for allowance. Issuance of a Notice of Allowability respectfully is requested. Applicants' representative, the undersigned, would be pleased to discuss at the Examiner's convenience, any further deficiencies or impediments to allowability, should such exist.

No fees are believed due with this Reply. However, if any additional fee is due or overpayment is made, please charge or credit our Deposit Account No. 03-2775, under Order No. 13744-00021-US, from which the undersigned is authorized to draw.

Respectfully submitted,

By 
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